

REMARKS/ARGUMENTS

Rejection under 35 U.S.C. §112, second paragraph

Claims 3-7 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, it was contended that the claim language—"at least two separate plates are completely separate from each other and can freely move independently of each other"—was definite because it was unclear whether Applicant was intending to claim axial or rotational movement. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection.

It is not clear to Applicant why the Examiner reached the conclusion that the claim language was indefinite. In particular, it is not clear to Applicant why he had to specify whether the movement was either axial or rotational. The Examiner cited neither statutory or case law nor PTO regulations for this requirement. Additionally, a review of the PTO's patent database revealed many patents having claims that recite relative movement but do not specify whether the relative movement is axial or rotational. Furthermore, if Applicant had specified the relative movement as axial (or rotational), the protection provided by the claims would be meaningless because a competitor could easily design around the claimed invention by making the relative movement rotational (or axial). Therefore, Applicant respectfully submits that the rejection is improper.

Rejections under 35 U.S.C. §§102 and 103(a)

Claims 3 and 7 rejected under 35 U.S.C. §102(e) as being anticipated by *Savoyard* (U.S. Patent 6,585,095). Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Savoyard* in view of *Yesnik* (U.S. Patent 5,048,654). Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Savoyard* in view of JP 405231443. Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Savoyard* in view of *Avers* (U.S. Patent 5,788,035).

Applicant respectfully requests reconsideration and withdrawal of the rejections, because *Savoyard* is not prior art to the present application under 35 U.S.C. §102(e). As indicated in the attached Declaration, the inventor of the present application conceived the claimed invention before August 7, 2000, which was the filing date of the *Savoyard* application. Therefore, *Savoyard* is not prior art to the claimed invention under 35 USC §102(e).

Additionally, *Savoyard* and the present application claim different inventions. The present invention claims a wet multi-plate clutch, while *Savoyard* claims an oil cooling system.

In light of the foregoing remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this amendment or the

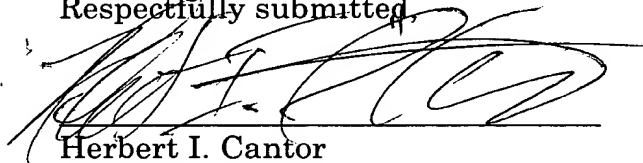
Application No. 09/940,519
Reply dated October 4, 2005
Response to Office Action dated August 3, 2004

application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #03876950357).

October 4, 2004

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'H. I. Cantor', written over a horizontal line.

Herbert I. Cantor

Registration No. 24,392

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
HIC:SZ:tlm (038769.50357US; 341062)